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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,543	05/25/2001	David E. Patterson	3017-56	6399

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EXAMINER

MORAN, MARJORIE A

ART UNIT PAPER NUMBER

1631

DATE MAILED: 12/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/866,543

Applicant(s)

PATTERSON ET AL.

Examiner

Marjorie A. Moran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-9 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 1, drawn to a virtual library, classified in class 707, subclass 102.
- II. Claim 2, drawn to a virtual library created by method steps different from that of Group I, classified in class 707, subclass 102.
- III. Claim 3, drawn to a virtual library created by method steps different from those of Groups I or II, classified in class 707, subclass 102.
- IV. Claim 4, drawn to a screening library, classified in class 707, subclass 102.
- V. Claim 5, drawn to a screening library created by method steps different from that of Group IV, classified in class 707, subclass 102.
- VI. Claim 6, drawn to a "use" of a subset of molecules, wherein said subset is generated by method steps similar to those of Group IV, classified in class 703, subclass 2.
- VII. Claim 7, drawn to a "use" of a subset of molecules, wherein the method steps are different from those of Group IV, classified in class 703, subclass 2.
- VIII. Claim 8, drawn to a "use" of a subset of molecules, wherein the method steps are different from those of Group IV or Group VIII, classified in class 703, subclass 2.
- IX. Claim 9, drawn to a "use" of a subset of molecules, wherein the subset is generated by method steps similar to those of Group V, classified in class 703, subclass 2.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-V are separate and distinct. The claims of each Group recite a virtual library/subset of combinatorial compounds. However, as each Group is generated by different method steps, the products created would be expected to be different and distinct, therefore

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each library or subset is considered a separate and distinct product from the library or subset of any other Group.

Inventions VI-IX are separate and distinct. The claims of each Group recite different methods of use of combinatorial libraries or "subsets" of compounds; however, as each Group recites different method steps, and the method of each Group may be performed without knowledge of or reference to any other method, each of Groups VI-IX is separate and distinct.

Inventions I-III are not related to any of Inventions VI-IX. None of the libraries of Groups I-III is limited to be used in a method of any of Groups VI-IX, and none of Groups VI-IX recite use of any of the libraries of Groups I-III, therefore none of Groups I-III are related to any of Groups VI-IX.

Invention IV is related to Inventions VI-VIII as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product of Group IV may be used in any of the methods of Groups VI-VIII. In addition, the methods of Groups VI-VIII appear to be able to be performed with the product of Group V, as set forth below.

Invention V is related to Inventions VII-IX as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product of Group V may be used in any of the methods of Groups VII-IX. In addition, the methods of Groups VI-VIII appear to be able to be performed with the product of Group IV, as set forth above.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Groups II-IX is not required for Group I, the search for Groups III-IX is not required for Group II, the search for Groups I-II and IV-IX is not required for Group III, the search for Groups I-III and V-IX is not required for Group IV, and the search for Groups I-IV and VI-IX is not required for Group V, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Claims 1-9 are subjected to restriction.

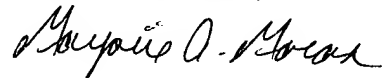
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marjorie A. Moran whose telephone number is (703) 305-2363. The examiner can normally be reached on Monday to Friday, 7:30 am to 4 pm EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (703) 308-4028. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to an LIE, Tina Plunkett, whose telephone number is (703) 305-3524.

MARJORIE MORAN
PATENT EXAMINER



December 16, 2002